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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
08/892,902	07/14/1997	CLINTON P. WALLER JR.	53473USA1A	7374

7590 09/24/2002

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EXAMINER

YAMNITZKY, MARIE ROSE

ART UNIT	PAPER NUMBER
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1774

37

DATE MAILED: 09/24/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

AS 37

Office Action Summary

Application No.

08/892,902

Applicant(s)

WALLER ET AL.

Examiner

Marie R. Yamnitzky

Art Unit

1774

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 12 July 2002.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,5,10-14,16,18,19,21-35,39 and 41-52 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 1,5,10-14,16,18,19,21,23,24 and 41-43 is/are allowed.
- 6) ☒ Claim(s) 22,25-35,39 and 44-52 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

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1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicants' amendment filed 07/12/02, which amends claims 22, 29-31, 33, 39, 47 and 49-51, has been entered.

2. Claims 1, 5, 10-14, 16, 18, 19, 21-35, 39 and 41-52 are pending.

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

3. Claims 1, 5, 10-14, 16, 18, 19, 21, 23, 24 and 41-43 stand allowed.

4. Claims 22, 25-35, 39 and 44-52 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

The application as originally filed does not provide support for the pore size limitation of claims 22, 25-35, 39 and 44-52. These claims place a numerical limitation on the size of the pores but do not limit how the pore size is measured. The numerical limitation is also open-

ended in the case of claims 22, 25-35, 39, 44-46, 48 and 50-52. It is the examiner's position that with no limit placed on how the claimed pore size is measured, the pore size limitation is not fully supported by the application as originally filed because there are various methods by which pore size can be determined but the application as originally filed only disclosed numerical values for bubble point pore size as measured according to ASTM F-316. It is also the examiner's position that the open-ended ranges for the numerical pore size limitation are not supported because the application as originally filed only disclosed numerical values of about 0.2 μm to about 2.0 μm with a preferred lower limit of 0.4 μm and a preferred upper limit of 0.8 μm . (The examiner would consider a claimed pore size range having a lower limit of "about 0.2 μm " or "about 0.4 μm ", with an upper limit of "about 0.8 μm " or "about 2.0 μm ", to be supported by the original disclosure provided the claim(s) specified that the pore size was a bubble point pore size measured according to ASTM F-316.)

5. Claims 22, 25-28, 32-35 and 48-52 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Malhotra et al. (5,500,668) in view of Carreira et al. (5,220,346) for reasons of record in Paper No. 33.

The examiner's position regarding the pore size limitation set forth in present claims 22, 33, 39 and 48-51 is the same as the examiner's position set forth in the rejection in Paper No. 33 with respect to the pore size limitation of claims 48 and 49.

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6. Claims 29-31, 39, 44 and 45 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Malhotra et al. (5,500,668) in view of Carreira et al. (5,220,346) as applied to claims 22, 25-28, 32-35 and 48-52 above, and further in view of Kojima et al. (5,677,067) for reasons of record in Paper No. 33.

7. Applicants arguments filed 07/12/02 have been fully considered but they are not persuasive.

There has been no criticality demonstrated with respect to the pore size limitations of the rejected claims.

It is also not clear that the membranes utilized to provide the inkjet receptors tested in the Rule 132 Declaration of Clinton P. Waller, Jr. had a pore size within the scope of the present claims. While the declaration states that each example was imaged on a membrane as disclosed in one of three patents that are incorporated by reference in the present application, a review of those three patents shows that they disclose membranes having a bubble point pore size outside the presently claimed range as well as membranes having a bubble point pore size inside the presently claimed range.

If it is applicants' position that the pigment and fluid management systems required by the present claims have a particular advantage when used in membranes having a bubble point pore size of about 0.2-2.0 μm (as measured by ASTM F-316), the examiner suggests presenting evidence by way of declaration or affidavit comparing inkjet receptors utilizing membranes

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representative of this pore size range compared to inkjet receptors utilizing membranes having pore sizes outside the range.

8. Any inquiry concerning this communication should be directed to Marie R. Yamnitzky at telephone number (703) 308-4413. The examiner works a flexible schedule but can generally be reached at this number from 6:30 a.m. to 4:00 p.m. Monday, Tuesday, Thursday and Friday, and every other Wednesday from 6:30 a.m. to 3:00 p.m.

The current fax numbers for Art Unit 1774 are (703) 872-9311 for official after final faxes and (703) 872-9310 or (703) 305-5408 for all other official faxes. (Unofficial faxes to be sent directly to examiner Yamnitzky can be sent to (703) 872-9041.)

MRY
09/18/02



MARIE YAMNITZKY
PRIMARY EXAMINER

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